

III. REMARKS

Claims 2 and 4-21 are not unpatentable over Brown in view of Bergum because the fundamental requirements for obviousness under 35 U.S.C. §103(a) are not established. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142).

The Examiner appears to suggest that merely because Brown and Bergum include memory devices there is legal "motivation" to combine the reference teachings. The Examiner also suggests that the safety measures disclosed in Brown can be modified by Bergum in such a manner as to result in Applicant's invention. It is respectfully submitted that a careful reading of both Brown and Bergum, without any prior knowledge of Applicant's invention, would not lead one to combine reference teachings, and the combination simply does not result in Applicant's invention.

It is apparent that Brown discloses three memory devices, RAM 102, battery backed RAM 104 and EEPROM device 106. Although there are three memory devices in Brown, which is the only similarity with Applicant's invention, there is no disclosure or suggestion of temporarily storing data in the third memory as claimed by Applicant. In Brown, the purpose of the memory devices is to store "data within the postage meter" in the "two (2) non-volatile memory devices." (Page 4, line 5). "All critical information within the system is maintained redundantly in both the CMOS battery-backed RAM 104 and the E²PROM 106. In

accordance with the invention any update of critical data within the CMOS non-volatile memory is immediately followed by a corresponding update or copy to the E²PROM non-volatile memory." (Page 4, lines 7-10). There is no disclosure or teaching here of temporarily storing data in the third memory as described by Applicant and recited in the claims. Brown merely deals with redundant storage of data.

Although there is also a safety measure in Brown, as suggested by the Examiner, it is unlike Applicant's invention. In Brown, this safety mechanism comprises is an immediate transfer of critical data, as it changes, to NVM. (Page 8, lines 31-32). There is also mention of a "Power Fail-Account Recovery" process. (Page 8, lines 34-45; Page 9, lines 7-12; FIG. 14). However, this system of Brown has no bearing or relationship to the device and system of Applicant's invention.

Furthermore, despite the Examiner's suggestion, there is simply no statement or disclosure in Brown teaching temporarily storing the data in a third memory. The Examiner is invited to cite to the specific page and line number of this disclosure in Brown.

Even if there were motivation to combine the two references, the incorporation of the invention of Bergum into the invention of Brown does not result in Applicant's invention.

Bergum discloses a decryptor 103, an encryptor 104, a RAM 105 and an EEPROM 106, as well as a micro controller 107. (See FIG. 1). The encrypted representation of keys are stored in EEPROM 106. Unencrypted keys are stored in RAM 105. The master key is stored in encryptor 104. (Col. 2, line 56 through Col. 3, line 2).

The unencrypted keys in RAM 105 are erased on power down, with the unencrypted master key being stored in decryptor 103. On

power up, the micro controller 107 verifies that the key in 103 is valid and if so, uses the encryptor 104 to decrypt the keys in EEPROM 106 and then store the decrypted keys in 105. (Col. 3, lines 3-29).

The security feature here is that if power is cut, the unencrypted keys in RAM 105 are lost. If the tamper circuit is triggered, the micro controller 107 will erase the keys stored in decryptor 103, and can also erase all keys in RAM 105. (Col. 4, lines 15-26). The tamper circuit erases the keys stored in the decryptor 103 because the decryptor 103 is always powered. (Col. 4, lines 33-36). This is unlike Applicant's invention.

To incorporate Bergum into Brown, one would at least have to add an encryptor 104 with other substantial modifications, with a result that is unlike Applicant's invention. While it might be nice to have the security of Bergum in Brown, there is nothing in the references that provides the requisite motivation to make the combination and any resulting combination is not the same as Applicant's invention since Bergum makes use of at least four (4) memory devices, the decryptor 103, an encryptor 104, a RAM 105 and an EEPROM 106. Applicant's invention only uses three (3) memory devices.

Brown is concerned with avoiding the loss of critical information as the status of data changes and accomplishes this as discussed on pages 8 and 9. The system of Bergum will not add any value to this functionality of Brown. While Bergum might offer additional security and anti temper safety, it offers absolutely nothing in furthering the objectives and point of Brown's invention. The possible option of adding the invention of Bergum to Brown as an additional safety measure, is simply not the requisite motivation that is required for obviousness under 35 U.S.C. §103(a).

The Examiner must be able to cite specific page and line numbers in Brown and Bergum where any implicit or explicit teaching that would motivate one to combine the reference teachings appear. (In re Rijakaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). It is respectfully submitted that there is no such motivation to be found in the references.

It is respectfully submitted that the Examiner may be using hindsight knowledge of Applicant's invention in piecing Bergum together with Brown in an attempt to reconstruct and obviate Applicant's invention. This is impermissible.

Even assuming *arguendo* there is motivation to combine the teachings of Brown and Bergum, the claimed invention is simply not realized.

In Applicant's invention, using claim 2 for example, the encryption key is stored in the second memory. The body of data, encrypted is stored in the first memory. Upon power up, the "encrypted" body of data is temporarily stored in the third memory. On power down, interruption or tamper, the data in the third memory is lost. Bergum requires four (4) memories. The decryptor 103, encryptor 104, RAM 105 and EEPROM 106. Applicant's invention has only three (3) memory devices. Thus, combining Bergum with Brown will not result in Applicant's invention, which is essential to sustain a 35 U.S.C. §103(a) rejection.

Thus, it is respectfully submitted that a *prima facie* case of obviousness over Brown in view of Bergum under 35 U.S.C. §103(a) cannot be established. There is no motivation to be found in the references themselves that would lead one to combine the reference teachings. Using hindsight knowledge of Applicant's

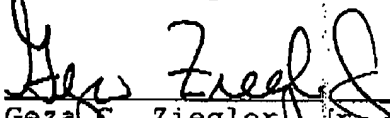
invention in any attempt to reconstruct Applicant's invention from the applied references is not permissible, and the resulting combination does not result in Applicant's invention.

Therefore, claims 2 and 4-21 are patentable over Brown in view of Bergum under 35 U.S.C. §103(a).

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment of \$110. for a one month extension of time as well as any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

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Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800 Ext. 134
Customer No.: 2512

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